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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,526	12/05/2000	Eduardo Ramirez de Arellano	LOSAS-0000	7475

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PATENT LAW OFFICES OF HEATH W. HOGLUND
256 ELEANOR ROOSEVELT STREET
SAN JUAN, PR 00918

EXAMINER

PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 01/28/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09 / 730526

Applicant(s)

mk-7

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 12/23/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-23 is/are pending in the application.
- Of the above claim(s) 14-20 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-13, 21-23 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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Response to Amendment

1. The Examiner makes this second Office Action non-final to clarify the issues.

Election/Restriction

2. Applicants arguments to the Examiner's making the restriction final were non-persuasive because they simply failed to address and overcome the Examiner's arguments regarding undue burden set forth in detail in the previous Office Action.

Specification

3. The rejections under this heading of the previous Office Action are withdrawn.

4. The amendment filed 12/23/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: addition of percentages "by weight" without citing support in the original specification or other support.

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Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

5. The amendments in response to the 35 USC 112 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 2,4,22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The addition of percentages "by weight" without having support in the original specification or other support is deemed to be new matter.

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Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. The rejections under this heading of the previous Office Action are withdrawn, and replaced by the following new rejections.
10. Claims 1,3-5,7-11,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiffer US 4349588 in view of Valle et al US 5203629.

Schiffer teaches to form a cementitious mortar comprising an aqueous based cement mixed with a miscible water-based adhesive (in the example, a *polyvinyl acetate latex* adhesive), and sand and/ or aggregate, which is applied to a wall or floor (enhancing concrete or concrete block surfaces) of a building with a trowel or similar tool. The applied layer is permitted to partially set but not dry, which is then scored to form indentations in which material is removed to form the indentations (col. 1, 27-42 and Example). Use of accelerant and specific setting times are not taught.

Valle teaches to modify the properties of concrete mortar formulations in which one or more additives may be added to modify the properties of the material. Concrete mortar formulations are specifically modified to (1) accelerate setting time and early strength development by adding calcium

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chloride (inorganic salt with halogen), calcium nitrate, etc (col. 4, 6-13), and (2) increase bond strength by use of organic bonding/ adhesive materials, specifically including polyvinyl acetate (same as Schiffer). Valle et al also teaches the inclusion of fine-sized mineral powders, column 6, 12-44.

Both references are directed to similar concrete mortars which use organic bonding/ adhesive materials, e.g. polyvinyl acetate. Schiffer teaches to partially set the concrete prior to removing part of the surface to form decorative indentations prior to complete setting, and Valle et al teaches to modify (accelerate) setting times by the addition of accelerant. Since time is a critical aspect in the building trade for reducing job time, and Valle et al teaches the use of an accelerant to accelerate setting time, it is the Examiner's position that the use of accelerant to decrease the partial setting of the concrete to allow earlier formation of the indents would have been an obvious variation to reduce job time/ improve cost efficiency. Exact set times would have been determined by varying type and amount of accelerant using routine experimentation since set time and type/ amount of accelerant have a cause effective-relationship, e.g. more accelerant results in more accelerated set times, per claim 4. Hence the specific set time limitations of the claims merely

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represent optimization by routine experimentation, absent a clear and convincing showing of unexpected or synergistic results to the contrary.

Per claim 7, the degree of setting/ hardening, i.e. to prevent reformation, would have been the choice of the skilled artisan to maximize the desired appearance of the final indentation. That is, hardening should be sufficient for making indentations, but not so soft that the walls of the indents run to deform the indentations.

Per claim 8, mixing formulation powders followed by addition of water or mixing powders with aqueous portions of the formulations would have been expected to provide equivalent results, absent clear and convincing showing of unexpected or synergistic results to the contrary.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Schiffer by incorporating the accelerant of Valle et al in order to better control the setting time of the concrete layer prior to indenting to improve job time/ cost efficiency.

11. Claims 6,12,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiffer US 4349588 in view of Valle et al US 5203629 and further in view of the Admitted Prior Art (APA) (specification page 5 and figure 2).

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Schiffer and Valle et al are cited for the same reasons discussed above, which are incorporated herein. Use of a rough patterning trowel on the partially set surface is not taught. However, the APA teaches that it is known in the prior art to apply similar concrete coatings to building structures, and then when semi-dry, to run a roughened trowel over the surface to create an attractive decorative finish. Such a roughened trowel would necessarily also form indentations in the partially set layer since the roughened surface would necessarily remove material, creating indentations, even though the pattern formed may be different from that of Schiffer. However, the outcome would merely be a difference in decoration or aesthetics. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Schiffer in view of Valle et al by utilizing the roughened trowel as disclosed by the APA in place of the indenting tool of Schiffer because of the expectation of also forming an attractive decorative surface on the settable layer.

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12. Claims 2,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiffer US 4349588 in view of Valle et al US 5203629 and further in view of Nishida et al US 3853577.

Schiffer and Valle et al are cited for the same reasons discussed above, which are incorporated herein. Particle sizes are not taught.

Nishida et al teaches a similar method of applying a decorative mortar-based layer onto surfaces including concrete. The coating composition comprises mixing an epoxy-based mortar, cement, aggregate, water, and additives (specifically citing on column 3, 37-38 a hardening accelerator of a chlorine (halogen)-containing salt). Earlier on column 3, aggregate sizes of more than about 60 wt% of 50-200 mesh (300-75 microns) are taught, which overlaps the limitations of claim 2. The subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made if the overlapping portion of the size ranges disclosed by the reference were selected because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Wortheim* 191 USPQ 90. While particle sizes of "approximately 1 millimeter or greater" are not disclosed, it is reiterated that Schiffer teaches use of "sand and /or an aggregate", sand conventionally

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being used in cementitious compositions in grain sizes on the order of a millimeter, which appears to meet the limitations of claim 22.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of Schiffer in view of Valle et al by incorporating the particle sizes of Nishida to provide sufficient bulk and strength to the cement layer.

13. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiffer US 4349588 in view of Valle et al US 5203629 and further in view of Nishida et al US 3853577 and further in view of the APA.

Schiffer, Nishida, and Valle et al are cited for the same reasons discussed above, which are incorporated herein. Removal of an exterior portion using a rough trowel is not taught. However, this point is previously discussed in section 11. Consequently it would have been obvious to one of ordinary skill to use a rough trowel as disclosed in the APA in the combined process of Schiffer in view of Valle and further in view of Nishida to provide an indented surface and which would have necessarily removed at least a portion of the millimeter range sand particles, in accordance with claim 23.

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14. Applicants remarks regarding the previous rejections have been read and considered, and issues brought out by those remarks are addressed in the new rejections. Since the previous rejections have been withdrawn, an Examiner's response to them is moot.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred J. Parker whose telephone number is (703) 308-3474.



Fred J. Parker

**FRED J. PARKER
PRIMARY EXAMINER**

January 24, 2003

2nf9-730526